

ATTORNEY DOCKET NO. 14114.0331U2
APPLICATION NO. 10/018,627

Group I includes claims 1-8 with the virus of SEQ ID# 1 which are drawn to a spumavirus isolated from a human, the first product and a method of killing dividing cells *in vitro*, the first method.

Group II includes claims 1-6 with the virus of SEQ ID# 2 which are drawn to a spumavirus isolated from a human.

Group III includes claims 1-6 with the virus of SEQ ID# 3 which are drawn to a spumavirus isolated from a human.

Group IV includes claims 1-6 with the virus of SEQ ID# 4 which are drawn to a spumavirus isolated from a human.

Group V includes claims 1-6 with the virus of SEQ ID# 5 which are drawn to a spumavirus isolated from a human.

Group VI includes claims 1-6 with the virus of SEQ ID# 6 which are drawn to a spumavirus isolated from a human.

Group VII includes claims 1-6 with the virus of SEQ ID# 7 which are drawn to a spumavirus isolated from a human.

Group VIII includes claims 9-11 which are a method of killing dividing cells *in vivo* inhibiting tumor formation or growth.

Group IX includes claim 12 which is drawn to a method for detecting a spumavirus.

Applicants provisionally elect Group I, claims 1-8, with traverse.

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Applicants submit that the subject matter of Groups I – VII relate to a single inventive concept. Claim 1 is a generic claim drawn to a genus of spumaviruses isolated from a human and shares the concept that it must comprise at least one of SEQ ID NOS:1-7, which are clearly related as each is sequence component of a disclosed virus. There is no basis asserted for why the Examiner believes that this shared defining concept is not novel or inventive. Thus, claim 1 meets the requirement of PCT Rule 13.2.

Alternatively, Examiner has improperly attempted to restrict this genus claim into multiple species claims with the restriction requirement. Because claim 1 is a genus claim, Applicants respectfully assert that this action could only properly be a species election. As discussed in the 37 C.F.R. § 1.141(a), an application may claim a reasonable number of species within a claimed genus as long as at least one genus claim encompassing all of the species is patentable. The Examiner has indicated that a *specific* species of spumavirus from a genus of 7 types, must be elected. Applicants assert that this is not an appropriate application of the 37 C.F.R. § 1.141, which is aimed at situations where there are unreasonable numbers of species claimed. The present situation is not a situation where the applicants are claiming a genus of compounds, for example, a set of 1000 different nucleic acid molecules, and also claiming each of the encompassed species separately, which would be an appropriate circumstance for application of the election of species requirement. Rather, applicants have claimed a genus of viruses defined by 7 sequences. Applicants are not required in the present application to elect a species when applicants have not claimed an unreasonable number of species. Thus, when a genus claim is found to be patentable, Applicants understand that the remaining members of the reasonable number of species must be examined.

Furthermore, Applicants note that in the present restriction the Examiner is defining the present virus by nucleotide sequence, rather than by the other characteristics of the spumavirus described in the application. Thus, the Office's 10 Sequence Rule should apply in the present

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restriction. With regard to that rule, MPEP 803.04 states that the Office will normally search up to 10 unrelated sequences in a single application. The MPEP mentions exceptions to this "10 sequence" rule, but none of them apply to the present circumstances. Thus, even if the Office does not accept the validity of the applicants' position based on genus-species considerations, applicants respectfully submit that the Office's own internal procedures call for examination of the 7 virus-defining sequences recited in the claim 1-7 as filed.

Furthermore, applicants traverse the restriction requirement for the following reasons. To be valid, a restriction requirement must establish both that (1) the "inventions" are either independent or distinct, and (2) that examination of more than one of the "inventions" would constitute a burden to the Examiner. Applicants note that the restriction/election requirement does not provide sufficient basis to indicate that examination of more than one of the "inventions" would overly burden the Examiner. Groups I-VII which correspond to SEQ ID NOS. 1-7 are define a narrow genus of spumavirus isolated from a human. In fact, they are all present in a single virus as exemplified in the application. As such a search by the examiner relating to a spumavirus isolated from human would necessarily be a search for each of the seven SEQ ID. Accordingly, the second requirement for a proper restriction has not been met. Applicants thus respectfully request reconsideration of the election requirement.

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Additionally, 37 CFR § 1.475 (b)(2) provides that claims to different categories of invention have unity of invention if the claims are drawn to the combination of categories consisting of a product, a process of use of said product. Claim 7 and claim 12 are claims drawn to a method of using the spumavirus of the invention. Furthermore, claims 8-11 represent further limitations of claim 7 and as such represent the same method. The Examiner in creating Group VIII has improperly read the claims in that group as a separate method rather than further limitations of the same method (claim 7). Thus, the claims of Groups I-VII (which should be rejoined as discussed above) and VIII are directed to a single inventive concept. Accordingly, the claims of Group VIII should be rejoined to and examined with the claims of Group I-VII. In the event that the Examiner does not find this traversal persuasive Groups VIII and IX should at least be rejoined with elected Group I.

For the above reasons, reconsideration or withdrawal of the restriction requirement is requested.

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No fees are believed to be due, however, the Commissioner is hereby authorized to charge any fees that may be required or credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.



Gwendolyn D. Spratt

April 10, 2003

Date